

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Gunter WAGNER et al.

Serial No.: 10/585,905

Filed: July 12, 2006

For: Fuel Feed Unit

Examiner: Comley, Alexander B.
Group Art: 3746

Conf. No.: 1616

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

Applicants request review of the Final Rejection in the above-referenced application. No amendments are being filed with this request.

The review is requested for the reasons set forth on the following pages 2-4.

REMARKS

There is a legal and factual deficiency in the following rejection:

1. Rejection of claim 1 as unpatentable over U.S. Patent No. 5,106,277 ("*Tuckey*") in view of U.S. Patent No. 5,121,021 ("*Ward*").

Error: *Ward* does not disclose that "the electric motor stator ring and the magnet shells comprise a single-piece body formed as a single piece of a single material", as expressly recited in independent claim 1 because the frame 12 and magnets 14 of *Ward* are made from two separate pieces of different materials.

Rejection of Claim 1

Independent claim 1 recites "wherein the electric motor stator ring and the magnet shells comprise a single-piece body formed entirely from a same material". As explained in detail below, the combination of *Tuckey* and *Ward* cited by the Examiner fails to disclose that the electric motor stator ring and the magnet shells comprise a single-piece body formed entirely of the same material.

The Examiner (at pg. 4 of the Final Office Action) acknowledges that *Tuckey* fails to teach or suggest the specific detail of a one-piece body comprising the stator ring (30) and the magnet shells (32), and cites *Ward* to cure this deficiency of *Tuckey*. According to the Examiner, *Ward* discloses the "final remaining element missing from that of the primary *Tuckey* reference". Applicants disagree.

According to the Examiner, "it would have been obvious to one having ordinary level of skill in the art at the time the invention was made [to] integrate the magnets with the stator (like *Ward*'s integration of the stator with the casing), since it has been held that forming in one piece an

article which has formerly been formed in two pieces involves only routine skill in the art. *Howard v Detroit Stove Work*, 150 U.S. 164”.

However, *Howard v. Detroit Stove Works* does not apply here, because *Detroit Stove Works* has all to do with riveting together multiple pieces of a stove that are formed from the same material. The riveting together of multiple pieces, however, does not form nor create a single-piece body.

Ward relates to “a frame and permanent magnet assembly for a dynamoelectric machine where the frame carries a plurality of permanent magnets. The frame is formed of iron powder particles that are bound together by a thermoplastic material” (see Abstract). However, there is no teaching or suggestion in *Ward* that the frame 12 and the magnets 14 can be made from a single-piece of a single material. See, e.g., col. 2, lines 8-10 of *Ward*, which states that frame 12 is molded to the magnets 14.

The claimed invention replaces prior art components that are formed from different materials, i.e., the stator ring and magnet shells, with a single-one piece component which is formed entirely from the same material. Moreover, the components of the claimed fuel feed unit that are formed into a single-piece body have different functions. That is, the claimed electric motor stator ring and the magnet shells each have different functions. Only the present application teaches that these components are manufactured from the same material. There is no teaching or suggestion in *Ward* of applicants’ claimed components which are arranged in a single-piece body that is made of the same material. That is, there is no teaching or suggestion in *Ward* with respect to an electric motor stator ring and the magnets that comprise a single-piece of a single material.

The Examiner (at pg. 4) asserts that “the composite frame material [of Ward] is a magnetic material and, accordingly forms a flux path for flux developed by permanent magnets” based on the

teachings of Ward at col. 5, lines 37-39". However, even assuming *arguendo* that the teachings of Ward at col. 5, lines 37-39 are applicable to Tuckey – which in any event applicants dispute – Ward fails to teach or suggest applicants' claimed feature, i.e., "wherein the electric motor stator ring and the magnet shells comprise a single-piece body formed as a single piece of a single material", as recited in independent claim 1. Fig. 1 of Ward clearly shows that the permanent magnet 14, i.e., magnet shells, are separate and distinct from the composite material for the frame 12. Moreover, the skilled person has no reason to modify the Ward structure to include the recited limitation of independent claim 1 such that the frame 12 and the permanent magnets 14 would be included in a single piece of a single material, absent an impermissible hindsight construction based on applicants' instant disclosure.

The combination of Tuckey and Ward thus fails to achieve independent claim 1, because Ward fails to provide what Tuckey lacks.

For at least the above reasons, the rejections of claim 1 under 35 U.S.C. §103(a) should be withdrawn.

Applicants respectfully submit that this application is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,
COHEN PONTANI LIEBERMAN & PAVANE LLP

By /Alfred W. Froebrich/
Alfred W. Froebrich
Reg. No. 38,887
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: June 2, 2011